

Application No.: 09/980,880
Reply Brief Dated: May 15, 2007

MAT-8189US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 09/980,880
Applicants: Yoshio GODA, et al.
Filed: September 3, 2002
Title: TOP SEALING PLATE, BATTERY USING THE TOP SEALING PLATE,
AND METHOD OF MANUFACTURING THE BATTERY (AS AMENDED)
TC/A.U.: 1745
Examiner: Robert W. Hodge
Confirmation No.: 1394
Docket No.: MAT-8189US

REPLY BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer of March 15, 2007, Appellants are submitting this Reply Brief for the above-identified application.

A. AMENDMENT

An amendment canceling claims 3 and 4 accompanies this Reply Brief. This amendment was inadvertently omitted when the Appeal Brief was filed. Appellants apologize for any confusion caused by this omission. Only claims 1-2, 5, 9, 10, and 12-29 remain in the application and are under appeal.

B. REJECTION UNDER 35 U.S.C. 112, FIRST PARAGRAPH

Withdrawal of the rejection under 35 U.S.C. 112, first paragraph, is hereby acknowledged. Examiner's Answer, page 8, lines 4-8.

C. RESPONSE TO THE EXAMINER'S ARGUMENTS

1. *The Strong Contact Portion and Weak Contact Portion Limitation*

The Federal Circuit has held that, "It is elementary patent law that all limitations are material." *Glaxo, Inc. v. Novopharm, Ltd.*, 42 USPQ2d 1257, 1261 (Fed. Cir. 1997). In their Appeal Brief, appellants pointed out that the Examiner had improperly ignored the limitation of "a contact pressure of said first contact portion is stringer than a contact pressure of said second contact portion" by giving it little or no patentable weight "because it does not further limit the structure of the apparatus." Appeal Brief, page 8, lines 14-20.

In response, the Examiner argues that he did not ignore a limitation; he merely gave it little or no patentable weight. Examiner's Answer, page 5, lines 7-16. The difference between ignoring a limitation and giving the limitation little or no patentable weight appears to be semantic at best. In each case, the limitation is being disregarded when the claimed invention is compared to the prior art.

The Examiner further argues 1) that the feature is not properly defined as a structural limitation, and 2) that the feature is inherent in the prior art because all seals including caulk will chemically form a better seal in some areas than in others. Examiner's answer, page 6, lines 13-17.

With respect to the first point, page 17, line 23, to page 18, line 24, of the specification describe the strong contact portion and the weak contact portion. This is shown in Figures 1(b) and 2(b), in which projection 31 of flange portion 14 contacts opening end 13 (see description on 21, lines 4-17, and page 24, lines 22-25). Appellants submit that the person of ordinary skill in the art would have no difficulty understanding

what is meant by the strong contact portion and the weak contact portion from these drawings and the accompanying description in the specification.

With respect to the second point, the Examiner asserts that all seals including caulk will chemically form a better seal in some areas than in others. No evidence has been offered in support of this assertion. See, *In re Lee*, 61 USPQ 1430, 1432-34 (Fed. Cir. 2002). It is merely the Examiner's unsupported opinion and is entitled to little weight. Further, this feature produces a reduction in resistance between the cap and the filter as well as a reduction in the internal resistance of the battery, indicating this feature is not present in conventional batteries. See, Figure 7 and page 27, lines 8-20, and page 28, lines 12-17.

The Examiner has not made the *prima facie* case. The strong contact portion and the weak contact portion limitation 1) further limits the structure of the apparatus, and 2) has not been shown to be inherent in the prior art. Therefore, combination of the references in the manner indicated by the Examiner does not product appellants' invention. For this reason, the rejection of claims 1-2, 5, 9, 10, and 12-29 as unpatentable over Onagawa in view of Nishino should be reversed.

2. *The Teachings of Nishino Have Been Taken out of Context*

In their Appeal Brief, appellants argued that the teachings of Nishino had been improperly taken out of context. Appeal Brief, page 12, line 6, to page 13, lines 11. In particular, appellants pointed out that Nishino requires not only a protrusion, but also a gasket to improve fluid leakage resistance. Nishino, Abstract, Purpose. If both the Nishino protrusion and the Nishino gasket were incorporated into Onagawa, the newly added gasket would intervene between the newly added protrusion and the bend portion

of Onagawa's sealing plate such that the resulting device would not satisfy the limitations of appellants' claims. Appeal Brief, page 11, line 5, to page 13, line 17.

In response, the Examiner argues that he is merely relying on the "conceptual teaching of a protrusion taught by Nishino," Examiner's Answer, page 6, lines 20-22. The difference between relying on a "conceptual teaching" and taking a teaching out of context again appears to be semantic at best. In each case, an isolated portion of the disclosure is being taken, without regard for the teachings of the rest of the reference.

All the relevant teaching of the cited reference must be considered in determining what it fairly teaches to one having ordinary skill in the art. *In re Mercier*, 185 U.S.P.Q. 774, 778 (CCPA 1975). Therefore, the Examiner has incorrectly concluded that it would have been obvious to include a protrusion in the outer periphery of the Onagawa flange portion in order to improve leakage resistance without also including a gasket.

The Examiner also argues that it is not improper hindsight reconstruction of the invention because it "takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made." Examiner's answer, page 7, lines 13-19. However, as described above and in appellants' Appeal Brief, the "knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made" does not include addition of only a protrusion in the outer periphery of the Onagawa flange portion in order to improve leakage resistance. It includes addition of a protrusion and a gasket in the outer periphery of the Onagawa flange portion in order to improve leakage resistance. Only with improper hindsight, based on appellants' disclosure, would one of ordinary skill in the art be motivated to omit the gasket.

The Examiner has not made the *prima facie* case. The Examiner has improperly reconstructed the invention by picking and choosing only so much as will support the rejection to the exclusion of other parts necessary to the full appreciation of what Nishino fairly teaches or suggests to one skilled in the art. For this additional reason the rejection of claims 1-2, 5, 9, 10, and 12-29 as unpatentable over Onagawa in view of Nishino should be reversed.

D. CONCLUSION

For the reasons discussed above and in appellants' Appeal Brief, the rejection of claims 1-2, 5, 9, 10, and 12-29 under 35 USC 103(a) as being unpatentable over Onagawa in view of Nishino should be reversed, and such action is earnestly solicited.

Respectfully Submitted,

RatherPrestia

Lawrence E. Ashery, Reg. No. 34,515
Bruce M. Monroe, Ph.D., Reg. No. 33,602
Attorneys for Appellants

LEA/BMM/ds/fp/bj

Dated: May 15, 2007

P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Director is hereby authorized to charge or credit Deposit Account No. 18-0350 for any additional fees, or any underpayment or credit for overpayment in connection herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: May 15, 2007.

Beth Johnson

144363